

REMARKS

Claims 1-48 and 50-53 are pending. Claims 1-10 and 20-39 were withdrawn from consideration, and claims 1-19, 40-48, and 50-53 stand rejected. By virtue of this response, claims 1-10 and 20-39 are cancelled, no claims have been amended, and no claims have been added. Accordingly, claims 11-19, 40-48, and 50-53 are currently under consideration. Cancellation and amendment of certain claims is not to be construed as a dedication or abandonment of any unclaimed subject matter by Applicants, and moreover Applicants have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants explicitly reserve the right to pursue prosecution of any subject matter in continuation and/or divisional applications.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Claims Rejected Under 35 USC §103

A. Claims 11-12, 14-15, 17-19, 40-41, 43-44, 46-48, and 50-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,932,045 to Campbell et al. (hereinafter "Campbell") in view of U.S. Patent No. 5,606,433 to Yin et al. (hereinafter "Yin"), and further in view of U.S. Patent No. 6,434,299 to Yudin et al. (hereinafter "Yudin").

Applicants respectfully traverse the rejection. The Examiner states on Page 4 of the Office Action (and similarly on page 5 of the previous Office Action mailed 3/16/2004):

...Yudin provides wavelength division multiplexing having diffraction gratings for optical elements such as holograms and substrates such as glass and plastic. See col. 8, lines 34-46 where Yudin teaches the following: Reflective concave diffraction grating 16 can be formed from a variety of materials and by a variety of techniques. For example, the reflective concave diffraction grating 16 can be formed by a three-dimensional hologram in a polymer medium, or by replicating a mechanically ruled master with a polymer material. In both cases, the polymer is overcoated with a thin, highly reflective metal layer such as, for example, gold or aluminum. Alternatively, the reflective concave diffraction grating 16 can be formed by chemically etching into a concave material such as, for example, glass or silicon, which is also overcoated with a thin, highly

reflective metal layer such as, for example, gold or aluminum. Such teaching is equivalent to providing reflective layers of gold or aluminum on substrates as required by instant claims 49-53. It would have been obvious to one of ordinary skill in the art to include reflective layers of gold or aluminum on substrate and to contain diffractive grating because Yudin teaches the application for forming three-dimensional holograms as cited above. (Emphasis added).

Applicants respectfully disagreed in their response filed June 15, 2004 and submitted that the combination of Campbell, Yin, and Yudin fails to disclose or suggest a multilayer optical article having “a reflective layer,” and other features as recited in claim 11 for a number of reasons. Applicants reassert those arguments herein.

In response to Applicants previous arguments, the Examiner maintains on page 6 of the present Office Action that:

Yudin teaches using reflective layers of gold or aluminum to form three-dimensional holograms in optical articles (col. 8, lines 34-46). Campbell teaches not only the flatness requirement, but also teaches the patented construction can also be used with bowed optical articles (see col. 2, lines 58-62 and col. 6, lines 60-68). Thus, the Examiner used analogous art and did not use hindsight in the rejections. (Emphasis added)

The Examiner has clearly failed to find a teaching, suggestion, or motivation in the prior art for the proffered combination to meet the features of the present claims and appears to be resting on the assertion that one could combine the references. Such a basis for an obviousness type rejection is clearly inadequate, and is inadequate precisely to guard against hindsight analysis – the fact that references can be combined is insufficient, “the prior art must suggest the desirability of the claimed invention.” MPEP 2143.01; *In re Mills* 916 F.2d 680 (916 F.2d 680). In this instance, the Examiner has failed to identify in the prior art any motivation or suggestion of the desirability for combining features in the references to meet the features of the present claims. For example, the Examiner has not identified anything in the prior art that suggests using a reflective layer with a multilayer optical article, much less with a multilayer optical article having the recited surface characteristics, is desirable. Therefore, the Examiner has clearly failed to carry the burden of establishing a *prima facie* case of obviousness and the rejection should be withdrawn.

The Examiner appears to be relying heavily on the assertion that Yudin discloses using holograms as a motivation for the combination. The assertion that Yudin teaches a reflective concave diffraction grating formed by a three-dimensional hologram, however, does not provide any teaching, suggestion, or motivation to combine the reference teachings, let alone to modify the disclosures of Campbell and Yin to meet the features of the present claims. That is, the disclosure by Yudin of a concave diffraction grating formed by a three-dimensional hologram, without more, does not suggest why one of ordinary skill in the art would combine the references, let alone combine and modify the references, to meet the specific features of the present claims. For example, a reflective concave diffraction grating formed by a three-dimensional grating in a polymer medium does not provide a teaching, suggestion, or motivation to one skilled in the art to include a reflective layer with a multilayer optical article having the recited features (or suggest the desirability of such). Therefore, the rejection should be withdrawn because the Examiner has failed to establish a suggestion, teaching, or motivation in the prior art such as a specific understanding or technical principle that would have suggested the combination to meet claim 11. See, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); MPEP §§ 2142, 2143.01.

Finally, the Examiner's response to Applicant's previous arguments further illustrates the hindsight inherent in the rejection. The Examiner states that Campbell discloses the construction may be used with bowed optical articles to support Yudin as analogous art and avoidance of hindsight analysis. However, Campbell discloses methods for forming "optically flat articles," having certain surface flatness, thickness uniformity, and bow characteristics. (see col. 1, lines 5-30). For example, Campbell discloses the optical article "advantageously [has] a bow of about 10^{-2} or less." To find that Campbell suggests analogous art or similar structures as the concave diffraction grating 16 of Yudin based on the use of the term "bow" in Campbell is clearly misleading. The analysis highlights the clear hindsight used in combining the references to meet the features of the present claims. Accordingly, one of ordinary skill in the art would clearly not combine the teachings of Campbell and Yudin as they disclose different structures, for different applications and the disclosure of Yudin would not have logically commended itself to an inventor's attending in considering his/her problem. See, *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Accordingly, for at least these reasons, Applicants request that the rejection be withdrawn and the instant claims be allowed.

B. Claims 16 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Yin and Yudin and further in view of U.S. Patent No. 4,921,319 to Mallik.

Claims 16 and 45 depend from claims 11 and 40 respectively, and should be allowable for at least similar reasons detailed above. Accordingly, Applicants request withdrawal of the rejection.

C. Claims 13 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Yin, and further in view of U.S. Patent No. 6,671,073 to Hegel.

Claims 13 and 42 depend from claims 11 and 40 respectively, and should be allowable for at least similar reasons detailed above. Accordingly, Applicants request withdrawal of the rejection.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 495812001900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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